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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/620,323	07/15/2003	William M. Becker	FOXR0004	7958
22862	7590	07/17/2006	EXAMINER	
GLENN PATENT GROUP 3475 EDISON WAY, SUITE L MENLO PARK, CA 94025			BOEHLER, ANNE MARIE M	
			ART UNIT	PAPER NUMBER
			3611	

DATE MAILED: 07/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/620,323	Applicant(s) BECKER ET AL.	
	Examiner Anne Marie M. Boehler	Art Unit 3611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 March 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 65-68, 72 and 75-101 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 65 and 94-97 is/are allowed.
- 6) ☒ Claim(s) 66-68, 72, 75-93, 98-101 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>5/5/06</u> | 6) <input type="checkbox"/> Other: _____ |

1. Applicant's Terminal Disclaimer, filed 10/6/05, overcomes the rejection based on obviousness double patenting.
2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 67, 68, 72, 75-93, 98, 99, 100, and 101 are rejected under 35 U.S.C. 102(a and e) as being anticipated by Gonzalez et al. (USPN 6,120,049).

Gonzalez shows a bicycle front fork including a lock-out valve 134 including a manually movable knob 138 and a blow-off valve 240 for blow-off passage 222. The blow-off valve is biased by spring 242 and compression of spring 242 can be altered by changing the position of nut 242. The nut is external to the compression chamber 112, as broadly recited, and is capable of manipulation manually, without tools. It is also removable so as to be adjusted exterior to the bicycle fork, as broadly recited, and the

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adjustment of the blow off valve is independent from that of the lock-out valve.

Therefore, Gonzalez meets applicant's claims, as broadly recited.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 66 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gonzalez et al. (USPN 6,120,049).

Gonzalez fails to specifically teach manipulating the blow-off valve threshold pressure without the use of tools. However, it is old and well known that a nut, such as the nut 210 of Gonzalez that controls the threshold pressure of the blow-off valve 240, may be manually manipulated. Therefore, it would have been obvious to one of ordinary skill in the art to manually adjust the nut, without the use of tools, in order to provide fine tuning of the blow-off valve.

6. Claims 65 and 94-97 are allowed.

7. Applicant's arguments filed March 8, 2006 have been fully considered but they are not persuasive.

Claim 65 is the only claim that specifies that the second adjuster is disposed externally to the bicycle fork. The other claims recite an "adjustment externally", but fails to what it is external. Therefore, the claims fail to distinguish over the prior art of record.

Applicant argues that the Gonzalez "blow-off" valve is not the same as applicant's and that it is not capable of "external" manipulation. Applicant argues that his blow-off valve is active in compression, not rebound. However, applicant has carefully drafted the claims that are currently rejected, not to define the specific operation of the blow-off valve. He has also not defined further distinguished the term "external". Therefore, the examiner assumes applicant means to define the invention broadly. Limitations cannot be read in from the specification. The broadest reasonable interpretation of the term "blow-off includes the rebound compression valve of Gonzalez. It also includes the compression blow-off valve structure taught by Gonzalez. This structure is adjustable by removing the valve from the fork and manually manipulating the nut outside of the fork. This operation is independent from adjustment of the lock-out valve. Therefore, the claim limitations are met, as broadly recited.

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anne Marie M. Boehler whose telephone number is 571-272-6641. The examiner can normally be reached on 7:30-5:00, Monday-Thursday, and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lesley Morris can be reached on 571-272-6612. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Anne Marie M. Boehler
Primary Examiner
Art Unit 3611

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